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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/630,461

07/30/2003

Lynda Fengler

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EXAMINER

INGBERG, TODD D

ART UNIT

PAPER NUMBER

2193

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,461

Applicant(s)

FENGLER ET AL.

Examiner

Todd Ingberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/30/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 – 34 have been examined.

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Legal words like method and system should be removed.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 8 – 12, 20 - 34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful,

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concrete and tangible result. No physical transformation is recited and additionally, the final result of the claim is for updating firmware which is not a tangible result because the claims do not explicitly claim the updating of a computer readable medium. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

Examiner Note

The claims are rejected under both 35 U.S.C. § 102. Lomas notifies the client of available firmware. The notification is not purely a unsolicited but a result of a detection process (download request). Applicant has not clearly and concisely claimed the invention to overcome the notification of Lomas.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 34 are rejected under 35 U.S.C. 102(b) as being anticipated by **Lomas et al.**, USPN 6,424,424 B1 issued July 23, 2002.

Claim 1

Lomas teaches a method for facilitating installation of peripheral device firmware (Lomas, Fig 2, #62), the method comprising:

transmitting a firmware availability notification (Lomas, Fig 2, #58);
receiving a firmware download request (Lomas, Fig 2, #50); and
transmitting a firmware file to a peripheral device for installation on the peripheral device (Lomas, Fig 2, # 62).

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Claim 2

The method of claim 1, wherein transmitting a firmware availability notification comprises transmitting a notification to the peripheral device. (Lomas, Fig 2, #58).

Claim 3

The method of claim 1, wherein transmitting a firmware availability notification comprises transmitting an email message to the user. (Lomas, Fig 2, 58).

Claim 4

The method of claim 3, wherein transmitting an email message to a user comprises transmitting a link to a network page at which firmware download can be requested. Lomas, Fig 2, # 50.

Claim 5

The method of claim 1, wherein receiving a firmware download request comprises receiving a firmware download request transmitted by a peripheral device. Lomas, Fig 2, # 50.

Claim 6

The method of claim 1, wherein transmitting a firmware file comprises transmitting a remote firmware update (RFU) file to the peripheral device. Lomas, Fig 2, # 52.

Claim 7

The method of claim 1, further comprising registering a peripheral device with a firmware service and determining whether to transmit a firmware availability notification based upon information that was collected through peripheral device registration. Lomas, Col 3, lines 25 – 35.

Claim 8

A system for facilitating installation of peripheral device firmware, the system comprising:
means for transmitting a notification to a device indicating that new firmware is available for installation;
means for receiving a firmware download request; and means for transmitting a firmware file directly to a peripheral device. Lomas, Fig 2, # 50, #52 and #56 to #58.

Claim 9

The system of claim 8, wherein the means for transmitting a notification comprise means for transmitting a notification to a peripheral device. Lomas, Fig 2, # 52 and #58.

Claim 10

The system of claim 8, wherein the means for transmitting a notification comprise means for transmitting an email message to a user, the email message including a link to a network page at which firmware download can be requested. Lomas, Fig 2, # 50, #52 and #56 to #58.

Claim 11

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The system of claim 8, wherein the means for transmitting a firmware file comprise means for transmitting a remote firmware update (RFU) file to the peripheral device. Lomas, Fig 2, # 52.

Claim 12

The system of claim 8, further comprising means for registering a peripheral device with a firmware service. Lomas, col 3, lines 25-35.

Claim 13

A method for facilitating installation of firmware on a peripheral device, the method comprising: a peripheral device receiving a firmware availability notification; and the peripheral device providing a related notification to a user. As per claim 1.

Claim 14

The method of claim 13, wherein the peripheral device providing a related notification to a user comprises the peripheral device posting a notification on a network page using a network server embedded in the peripheral device. As per claim 1.

Claim 15

The method of claim 13, wherein the peripheral device providing a related notification to a user comprises the peripheral device transmitting a message to a user computing device. Lomas, Figure 2, #58 to client.

Claim 16

The method of claim 13, wherein the peripheral device providing a related notification to a user comprises the peripheral device displaying a notification. As per claim 3, display of email.

Claim 17

The method of claim 13, further comprising the peripheral device receiving a request to install available firmware. Lomas, Figure 2, #50, communications of new printer

Claim 18

The method of claim 17, further comprising the peripheral device transmitting a firmware download request to a firmware service. Lomas, Figure 2, #50, communications of new printer.

Claim 19

The method of claim 18, further comprising the peripheral device receiving a firmware file and installing the firmware file on the peripheral device. Lomas, Figure 2, #60 and #62 – download and load/install.

Claim 20

A system for facilitating installation of firmware on a peripheral device, the system comprising: means provided on a peripheral device for receiving a notification from a firmware service that new peripheral device firmware is available for download; and means provided on the peripheral device for providing a related notification to a device user. As per claim 1.

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Claim 21

The system of claim 20, wherein the means for providing a related notification comprise an embedded network server that is configured to post a notification on a network page. Lomas, Fig 2, #50 – 58, server side).

Claim 22

The system of claim 20, wherein the means for providing a related notification comprise means for transmitting a message to a user computing device from the peripheral device.

As per claim 3.

Claim 23

The system of claim 20, wherein the means for providing a related notification comprise means for displaying a notification in a display of the peripheral device. As per claim 16.

Claim 24

The system of claim 20, further comprising means for receiving and installing a firmware file on the peripheral device. As per claim 19.

Claim 25

A firmware service stored on a computer-readable medium, the service comprising:
 logic configured to transmit firmware availability notifications directly to peripheral devices;
 logic configured to receive firmware download requests from the peripheral devices; and
 logic configured to transmit firmware files to the peripheral devices.

As per claims 2 and 5 and Figure 2, #60.

Claim 26

The service of claim 25, wherein the logic configured to transmit firmware files comprises logic configured to transmit remote firmware update (RFU) files to the peripheral devices. As per claim 6.

Claim 27

The service of claim 25, further comprising logic configured to register peripheral devices with the firmware service. As per claim 7.

Claim 28

The service of claim 27, further comprising logic configured to determine whether to transmit firmware availability notifications based upon collected peripheral device registration information. Lomas, col 3, lines 16 – 35.

Claim 29

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A peripheral device, comprising: logic configured to directly receive firmware availability notifications that are transmitted by a firmware service via a network; and logic configured to provide related notifications to a user. As per claim 3 – email is on a network.

Claim 30

The device of claim 29, wherein the logic configured to provide related notifications comprises an embedded network server that is configured to post notifications on network pages accessible via a network browser. Lomas, Figure 1, network.

Claim 31

The device of claim 29, wherein the logic configured to provide related notifications comprises logic configured to transmit email messages to a user computing device that indicate that firmware is available for installation. As per claims 3 and 7 .

Claim 32

The device of claim 29, further comprising a display and wherein the logic configured to provide related notifications comprises logic configured to present notifications in the display.
As per claim 23.

Claim 33

The device of claim 29, further comprising logic configured to receive a firmware installation request and logic configured to transmit a firmware download request to the firmware service.
As per claim 19.

Claim 34

The device of claim 33, further comprising logic configured to receive and install firmware files.
As per claim 19.

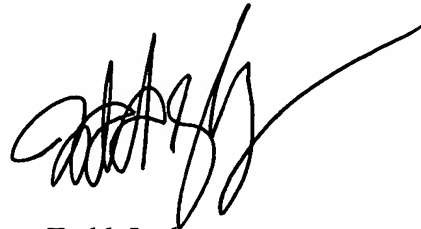
Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Todd Ingberg', with a long, sweeping horizontal line extending to the right.

Todd Ingberg
Primary Examiner
Art Unit 2193

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